REMARKS

With the entry of the amendments above, claims 1, 3, 4, 6-9, 11-14, 16, 18, 20 and 22-31 and 33 will be pending in this application. Applicants have canceled claim 34 as well as non-elected claims 35 and 36 to expedite prosecution and have amended claims 25 and 26 to correct a typographical error. Applicants have amended claim 1 to incorporate the limitations of canceled claims 2, 5, 10, 15, 17, 19 and 21 and have amended the remaining claims to conform them to the other amendments.

Applicants have amended the specification to overcome the objection in paragraph 3 of the Action.

Applicants have canceled claim 32 to overcome the objection in paragraph 4 of the Action and have amended claim 18 as suggested by the Examiner in paragraph 5 of the Action. Withdrawal of the claim objections is respectfully requested.

The amendments above overcome the rejection under 35 USC 112, first paragraph, in paragraph 7 of the Action, the withdrawal of which is respectfully requested.

Claims 1-33 stand rejected under 35 USC 112, first and second paragraphs, for the reasons stated in paragraphs 8 and 10 of the Action, respectively. In essence, the Examiner says that persons skilled in the art cannot practice the claimed invention because "the claim does not provided [sic] any units for this value or a standard method by which this experimental value is obtained." These rejections and their supporting reasoning are respectfully traversed.

Applicants will first address the rejection under 35 USC 112, second paragraph: since the claims are definite, it will follow that the specification of this application contains sufficient disclosure that persons skilled in the art, relying upon their level of knowledge as of the filing date of this application, will be able to practice the invention as claimed.

The reasoning and support of the indefiniteness rejection relies upon the alleged failure of the claims set forth units of metal adhesion. The Examiner seems to believe that the claims must contain a complete explanation of how to read them, without resort to the specification. This

view of the facts and law is incorrect, for it overlooks the recently-issued guidelines on indefiniteness rejections embodied in MPEP 2173 and MPEP 2174. As the MPEP explains, at MPEP 2173.01:

> A fundamental principle contained in 35 USC 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. Applicant[s] may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

As explained in MPEP 2173.02, "The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 USC 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available." The same section goes on to state, "Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire." MPEP 2173.02 also emphasizes that "Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made."

Under these criteria, it is evident that persons skilled in this art would readily understand the scope of the claims with respect to the metal adhesion limitation by reference to the specification of this application, which explains at page 7, lines 11-21, what the numerical metal adhesion values to which the claims refer signify in terms of the resistance to removal of the metallized film by adhesive tape. The type of tape is specified, the size of tape is specified, and the amount of metal removed by percentage is set forth in numerical terms in the form of ranges of metal removed corresponding to numbers. The metal adhesion values in this application do

not require units, since they represent arbitrary scores based on the table on page 7. Persons skilled in this art would simply look to the specification of this application and know immediately what the claimed metal adhesion values mean. If the Examiner has a suggestion for language that would achieve the same result as the claims as they now stand, without narrowing the scope of the claims, applicants stand ready to consider such suggestions. MPEP 2173.02 states in this regard, "Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement." Since the Examiner has presented no factual or legal basis to question the definiteness of the claims other than the failure of the metal adhesion values to include units, the rejection of claims 1-33 under 35 USC 112, second paragraph, should be withdrawn.

Since it is apparent that the claims clearly define the metes and bounds of the subject matter applicants seek to protect in this application, the rejection of the claims as lacking an enabling disclosure set forth in paragraph 10 of the Action should likewise be withdrawn. The Examiner criticizes the specification on the basis that "the recited testing method was not conducted according to a standard method recognized in the art." The Examiner also states "that other testing conditions that are not recited have an effect on the amount of metal removed, such as the rate or force at which the tape is removed, and the angle or direction utilized to remove the tape at [sic] which the test was conducted." The Examiner concludes by arguing, "Hence, the specification does not describe the testing method in sufficient detail to allow one having ordinary skill in the art to make the invention such that it has a 'metal adhesion' as instantly claimed."

The difficulty with this argument is that the Examiner's opinion is not supported by fact. The Examiner has cited no evidence to create a *prima facie* case that persons skilled in the art would not be able to make and use metallized films having the claimed metal adhesion values. The fact that the test method described in the specification is not recognized in the art is, as the

Examiner well knows, immaterial to enablement, since the specification may disclose and rely upon testing methods that are otherwise not known in the art. The Examiner does not appear to contend that persons skilled in the art would not *understand* the test method applicants provide, only that it is not complete enough in the Examiner's personal opinion. *See*, MPEP 2164.04, which imposes upon the Examiner "the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention." This same section of the MPEP states "A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 USC 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support." The Examiner has failed to provide any reasoned, factual basis for criticizing the sufficiency of the disclosure of the metal adhesion testing method, merely setting forth suppositions and speculations without any offered basis in fact. If the Examiner has substantive evidence, as opposed to mere personal opinion, the Examiner should have presented it in the pending Action.[1] Because of the insufficiency of the Examiner's case for lack of enablement, the enablement rejection of claims 1-33 under 35 USC 112, first paragraph, should be withdrawn for lack of evidentiary support.

Applicants have overcome the rejection of claims 23-27 under 35 USC 112, second paragraph, in paragraph 11 of the Action by correcting their dependency. Withdrawal of this rejection is respectfully requested.

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[1] Applicants thus respectfully submit that if the Examiner chooses to cite evidence in the form of documents with the next Action to support the rejections under 35 USC 112 set forth in paragraphs 8 and 10 of this Action, it would be unfair to make such an Action final since the citation of evidence would not have been necessitated by applicants' claim amendments. If the Examiner is relying on personal knowledge, applicants call upon the Examiner to cite documentary evidence or provide a declaration in accordance with 37 CFR 1.104(d)(2).

Claims 1-14 and 23-34 stand rejected as anticipated by Kurokawa. This rejection has been mooted by the incorporation into independent claim 1 of the subject matter of claims 15, 17, 19 and 21, which are not subject to this rejection.

Claims 15-22 stand rejected under 35 USC 103(a) on Kurokawa in view of Migliorini, Kemp-Patchett or Davis. This rejection is respectfully traversed.

The Examiner appropriately recognizes that Kurokawa does not disclose the claimed wax additives. The specification of this application shows that persons of ordinary skill in the art would not have been motivated to look to the disclosures of either Migliorini, Kemp-Patchett or Davis to bridge the gap between Kurokawa and the secondary references so as to arrive at the claimed invention.

The specification of this application incorporates by reference the entire disclosure of Kurokawa at page 2, lines 3-8. As explained there, Kurokawa discloses:

> the use of a four layer packaging film having a polyolefin resin layer sandwiched between a polyolefin resin layer comprising a petroleum or terpene resin and a heat sealable layer or non-sealable winding layer. A metal layer is then deposited on the surface of the polyolefin resin layer. The metal layer is deposited following the discharge treatment of the polyolefin resin layer.

Comparative Example 2 in this application is, as can be seen by comparing its conditions with Kurokawa, a reproduction of Kurokawa's film. As disclosed in this application, when applicants produced Kurokawa's film, they did not see as high metal adhesion strength as in Example 1 of this application, which was carried out in accordance with this invention. Kurokawa also does not teach using waxes to improve metal adhesion, so there is nothing within Kurokawa that would have motivated a person of ordinary skill in the art to look to disclosures of waxes to remedy Kurokawa's metal adhesion deficiencies as revealed in Comparative Example 2 of this application. Indeed, at the time this invention was made persons of ordinary skill in the art would have avoided using waxes because their viewpoint at the time of the invention was that an additive like wax, which was being used as a slip additive due to its low molecular weight and

migratory behavior, could be detrimental to achieving barrier properties and metal adhesion. Thus, it would have been unexpected that wax could be used as a metal adhesion promoter.

Persons of ordinary skill in the art would not have seen Migliorini or Kemp-Patchett as overcoming these problems. Both of these patents draw the inference of using microcrystalline wax as part of the HDPE metal adhesion layer from Lu U.S. Patent No. 4,870,122 (see, Migliorini, col. 1, line 65 – col. 2, line 7; Kemp-Patchett, col. 6, lines 55-67). Applicants submit concurrently herewith a copy of Lu in the form of an Information Disclosure Statement. Lu describes making oriented HDPE films wherein a small amount of PE wax can be added to improve the tendency of oriented HDPE films from splitting or tearing in the TD direction during the packaging process. This has nothing to do with using PE wax as a metal adhesion promoter and is not evidence of such a motivation. The use of PE wax in Lu's film is as a sort of plasticizer to make the oriented HDPE film less brittle and less prone to breaking during packaging. Lu's film does not appear to be contemplated for metallizing.

Moreover, using HDPE as a metal adhesion layer alone results in very good metal adhesion as explained in col. 2 of Migliorini. Without applicants' disclosure at hand as a guide, no person of ordinary skill in the art would have been motivated to add a PE wax to Kurokawa's films to promote metal adhesion. The addition of PE wax to HDPE is very unlikely to improve further the metal adhesion properties. The excellent results achieved by this invention come from the addition of a small amount of PE wax to a polypropylene layer -- which inherently does not have high metal adhesion – to significantly improve the metal adhesion of a primarily propylene homopolymer layer. This improvement in metal adhesion in a propylene homopolymer layer is not taught by Migliorini or Kemp-Patchett.

Davis describes using waxes to "fill" the amorphous region of a polypropylene film and thus improve MVTR barrier properties. Davis also teaches that it is believed that the wax forms a continuous layer on the surface of the "cap layers" which also reduce moisture transmission and that this wax layer forms on the cap layers through migration from the core. The Examiner

argues that Davis together with Kurokawa would have suggested using wax as an additive to improve metal adhesion. However, at the time of the invention, the prior art taught that wax was to be used as a slip additive for reducing COF. For example, Balloni U.S. Patent No. 4,590,125 and Brandt U.S. Patent No. 4,394,235 (copies of which are also submitted with the concurrently-filed IDS) both teach use of wax additive as a slip agent for reducing COF. Kurokawa, however, suggests avoiding using wax as a slip agent in the design of high barrier metallized films for fear that the low molecular weight wax would vaporize during metal vapor deposition and "pinhole" the metal, thus degrading barrier properties. Davis explains the low molecular weight and migratory nature of waxes. Indeed, Kurokawa specifies in col. 4, line 49 that an "inorganic lubricant" is preferred (wax would be an organic lubricant). Thus, persons of ordinary skill in the art at the time of the invention would not have contemplated using wax as a metal adhesion promoter. The rejection of claims 15-22 under 35 USC 103(a) on Kurokawa in view of Migliorini, Kemp-Patchett or Davis should be withdrawn.

In light of the foregoing, early action allowing claims 1, 3, 4, 6-9, 11-14, 16, 18, 20 and 22-31 and 33 is solicited.

Attached hereto is a marked-up version of the changes made to the claims by this amendment, captioned "**Version with markings to show changes made**".

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952, Ref. 361752000400.

Respectfully submitted,

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